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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,723

08/11/2006

Dirk Muehlhoff

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3769

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,723	<b>Applicant(s)</b> MUEHLHOFF ET AL.	
	<b>Examiner</b> david shay	<b>Art Unit</b> 3769	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on November 23, 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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The drawings are objected to because the element 2 in Figure 1; the elements in Figure 3; element A in Figure 4; element 20 in Figure 8; elements H, T, and 22 in Figure 9; and elements T and 23 in Figure 8 are not labeled with indicia indicative of their function, further, the ordinates in Figures 5-7 are not labeled with a meaningful legend, still further, element 5 in Figures 2-4 do not appear to refer to the same thing (see 37 C.F.R. 1.84(p)(4)).

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “elevation lines”; the “scanning unit”; the “control unit”; the “adjustable optics”; the “deflecting unit”; the “control unit begins the spatial spiral on a part of the transparent material that is posteriorly located”; the “control unit arranges the main axis such that posterior parts of the transparent material are not obscured by previously created optical breakthroughs in anterior parts” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Arguments drawn to Juhasz et al (US '438) are moot, as this rejection has been withdrawn. With regard to the rejection based on Swinger et al, applicant argues that the interpretation of Swinger et al, set forth in the previous office action is "contrary to the description of the spatial spiral that is disclosed in the application" (see the instant response, page 14, last sentence). The examiner must respectfully disagree. As set forth below, Swinger et al clearly disclose a "spatial spiral" in Figure 7. It is further noted that applicant's reference to paragraph [0014] of the pre grant publication of the instant application (which is the first full paragraph on page 4 of the originally filed disclosure), while sufficient to overcome Juhasz et al (US '438), is insufficient to overcome the Swinger et al reference as now applied to the claims. The instant claims read on the spatial spiral of Swinger et al as illustrated in Figure 7 thereof, as can be clearly seen by the descriptions of the claim terms at page 4, first paragraph, the last two sentences therein, of the originally filed disclosure.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, “the transparent material parts” lacks positive antecedent basis, and it is unclear which parts of the transparent material (e.g. anterior, posterior, some other parts) to which this phrase refers.

Claims 12, 13, 15-16, 18-22, and 24-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Swinger et al.

Swinger et al teach a device and method such as claimed including the production of a spiral wherein the major axis of the spiral is generally or substantially perpendicular to the optical axis (see e.g. Figure 7, element 619 and column 20, lines 51-65); teaches beginning the scan at a posterior location (see column 25, lines 32-37). The device includes a two dimensional scanner that scans the focal point in a plane perpendicular to the optical axis (see Figure 6, element 104 and column 17, lines 1-10), and adjustable optics that adjusts the focal point substantially anteriorly and posteriorly (see Figure 6, element 106 and column 17, lines 21-30), and a controller (see Figure 6, element 114 and column 17, line 50 to column 19, line 64). The control signals claimed for the various scanning mechanisms are inherently required to produce a spiral cut.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swinger et al in combination with Juhasz et al. Swinger et al teach a device and method such as claimed including the production of a spiral wherein the major axis of the spiral is generally perpendicular to the optical axis, as set forth above, but does not include any discussion of control unit arranging the main axis or the elevation lines such that posterior parts of the transparent material are not obscured by previously created optical breakthroughs in anterior parts of the transparent material. Juhasz et al teach the desirability of performing posterior ablations prior to anterior ablations (see column 7, lines 15-23). It would have been obvious to the artisan or ordinary skill to employ posterior ablation taught by the method and device of Juhasz et al, either by aligning the planes appropriately, or orienting the axis of the spatial spiral appropriately, since these are the two ways one would perform the posterior ablations prior to the anterior ablations when incising the tissue in a spatial spiral pattern, in the method and device of Swinger et al since this produces more accurate results, as taught by Juhasz et al, or alternatively, to employ the method and device of Swinger et al in the method and device of Juhasz et al, since this is a versatile system that can perform numerous types of surgical procedures on the eye, as taught by Swinger et al, and since the spiral cut is equivalent to the plane or curved cut, as shown by Swinger et al, thus producing a device and method such as claimed.

Applicant's arguments filed November 23, 2009 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

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Applicant's arguments with respect to claims 12-17, 25, and 29 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769